

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

MAILED

AUG 30 2005

U.S. PATENT AND TRADEMARK OFFICE  
BOARD OF PATENT APPEALS  
AND INTERFERENCES

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

Ex parte WARNER R. T. TEN KATE

Appeal No. 2005-1473  
Application 09/182,825

ON BRIEF

Before THOMAS, JERRY SMITH and BARRETT, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 28-44, which constitute all the claims pending in the application.

The disclosed invention pertains to the manner in which program information, such as a television program, is coded and stored on a recording medium for subsequent editing and/or playback.

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Representative claim 28 is reproduced as follows:

28. A presentation program portion stored on a computer readable medium, said presentation program portion comprising:

a sub-presentation program segment comprising:

a presentation element with a play-out specification indicating how the presentation element is to be played; and

an interface program segment defining a reference timing for the play-out specification, wherein the reference timing is defined independent of the presentation element.

The examiner relies on the following references:

Gudmundson et al. (Gudmundson)	5,680,619	Oct. 21, 1997
Moorby et al. (Moorby)	5,892,507	Apr. 06, 1999
		(filed Aug. 12, 1996)

Claims 28-34 stand rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Claims 28-32, 34-40 and 42 stand rejected under 35 U.S.C. § 102(e) as being anticipated by the disclosure of Moorby. Claims 33, 41, 43 and 44 stand rejected under 35 U.S.C. § 103(a). As evidence of obviousness the examiner offers Moorby in view of Gudmundson.

Rather than repeat the arguments of appellant or the examiner, we make reference to the briefs and the answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the examiner and the evidence of anticipation and obviousness relied upon by the examiner as support for the art rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellant's arguments set forth in the briefs along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that none of the examiner's rejections are supported based on the record before us. Accordingly, we reverse.

We consider first the rejection of claims 28-34 under 35 U.S.C. § 101 as being directed to non-statutory subject matter. The rejection states that the claims are directed to non-statutory subject matter because (1) the claimed subject matter does not fall within one of the four statutory classes of inventions under § 101; and/or (2) the claimed subject matter falls within the mere idea or abstract intellectual concept exception to § 101; and/or (3) the claimed subject matter falls by analogy to the printed matter exception. On the latter point, the examiner asserts that the claimed data structure is a non-

functional data structure and is analogous to printed matter. The examiner also asserts that there is no manipulation of the data structure to achieve a practical application [answer, pages 3-5].

Appellant argues that the claims recite a physical interrelationship between information in memory because the sub-presentation program segment comprises both the presentation element and the interface program segment. Thus, appellant argues that each of the rejected claims recites a patentable data structure in memory [brief, pages 3-6].

The examiner responds that the rejected claims are directed to a non-functional data structure similar to recorded music [answer, pages 9-11]. Appellant responds that the rejected claims relate to physical organization of data on a storage medium [reply brief, pages 2-3]. Appellant also responds that the claims relate to a type of play-out specification which is functional [id., pages 5-7].

We will not sustain the examiner's rejection of claims 28-34 under 35 U.S.C. § 101. We note that rejected claim 28 is essentially the same as not rejected claim 37 except for the respective preambles of these claims. Claim 37 recites "[a]n information carrier comprising a coded presentation comprising."

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This claim was not rejected under 35 U.S.C. § 101 presumably because the examiner considered this claim to be directed to a physical data structure which had functional data stored thereon. Claim 28, which was rejected by the examiner, has essentially the same recitations in the body of the claim as claim 37, but the preamble of claim 28 recites "[a] presentation program portion stored on a computer readable medium, said presentation program portion comprising." The claim is directed to "said presentation program portion," but the antecedent basis for the presentation program portion specifically recites that it is "stored on a computer readable medium." Thus, in our view, the presentation program portion of claim 28 and its sub-presentation program segments cannot be interpreted apart from the computer readable medium upon which they are stored. In other words, we find that the invention of claim 28 relates to a physical storage medium to the extent that not rejected claim 37 relates to such a physical storage medium. Therefore, the same reasons which led the examiner not to reject claim 37 apply equally well to claim 28. We agree with appellant that the invention of claim 28 relates to the physical arrangement of a data structure as opposed to the content of the information making up the presentation element.

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Therefore, we agree with appellant that claims 28-34 are directed to statutory subject matter.

We now consider the rejection of claims 28-32, 34-40 and 42 under 35 U.S.C. § 102(e) as being anticipated by Moorby. Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention as well as disclosing structure which is capable of performing the recited functional limitations. RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir.); cert. dismissed, 468 U.S. 1228 (1984); W.L. Gore and Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

The examiner has indicated how he reads the claimed invention on the disclosure of Moorby [answer, pages 5-6]. With respect to each of the independent claims, appellant argues that Moorby fails to teach or suggest any specific structures stored within a computer readable medium. Specifically, appellant argues that the graphical representations shown in Moorby reveal nothing about the underlying data structures. Appellant also argues that Moorby fails to disclose that the reference timing is defined independent of the presentation element because the

graphical representations of the timing information in Moorby are represented by sizing the representation of the presentation element [brief, pages 8-10].

The examiner responds that Moorby teaches the presentation segments stored in a way to be played out in the timing specification as graphically illustrated by the icons. The examiner asserts that since the storage in Moorby contains both the playout data and the playout specification indicating how the presentation element is to be played, the limitations of the claims are met [answer, pages 11-12].

Appellant responds that the graphical user interface of Moorby only shows visual content, but does not disclose the structures in memory that relate to this interface. Appellant argues that the examiner has failed to identify where the claimed data structures are disclosed in Moorby [reply brief, pages 7-9].

We will not sustain the examiner's rejection of any of the claims based on anticipation by Moorby. Not only is appellant correct that the examiner has failed to show data structures in Moorby which meet the claimed data structures, but the examiner has never addressed the limitation in each of the independent claims that the reference timing is defined independent of the presentation element. This language in each

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of the independent claims is not mentioned in the examiner's rejection and is also not mentioned in the examiner's response to arguments. Appellant has argued that the timing in Moorby is not independent of the presentation elements because the graphical representations of the timing information in Moorby are represented by sizing the representation of the presentation element. The examiner has not responded to this argument which appears to render Moorby unacceptable as an anticipatory reference. On the record before us, we agree with appellant that the examiner has failed to support the rejection based on Moorby.

We now consider the rejection of claims 33, 41, 43 and 44 under 35 U.S.C. § 103 based on Moorby and Gudmundson. In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion



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or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See Id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Only those arguments actually made by appellant have been considered in this decision.

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Arguments which appellant could have made but chose not to make in the brief have not been considered and are deemed to be waived [see 37 CFR § 41.37(c)(1)(vii)(2004)].

With respect to dependent claims 33 and 41, since these claims depend from claims 28 and 37 respectively, and since Gudmundson does not overcome the deficiencies in Moorby discussed above, we do not sustain the rejection of these claims for the reasons discussed above with respect to claims 28 and 37.

With respect to independent claim 43 and dependent claim 44, the examiner has indicated how he finds the claimed invention to be obvious over the collective teachings of Moorby and Gudmundson [answer, pages 7-9]. Appellant argues that neither Moorby nor Gudmundson teaches the specific data structure arrangement as recited in these claims [brief, pages 10-13].

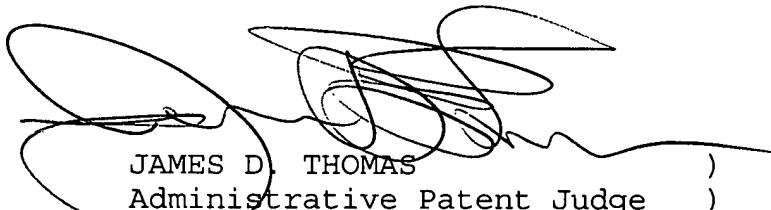


We will not sustain the examiner's rejection of claims 43 and 44 based on Moorby and Gudmundson. Independent claim 43 recites a method for accessing, selecting and retrieving specific information from self-contained data structures. As argued by appellant, the examiner has failed to identify any specific data structures in the applied prior art. The fact that similar information may be available in the prior art does not provide any teaching as to how that information is stored within memory.

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The claimed invention recites the manner in which the information is stored as a self-contained data structure. Thus, the physical arrangement of the data within the data structure is a key aspect of the claimed invention. No such data structure is taught by either Moorby or Gudmundson.

In summary, we have not sustained any of the examiner's rejections. Therefore, the decision of the examiner rejecting claims 28-44 is reversed.

REVERSED

  
JAMES D. THOMAS  
Administrative Patent Judge )  
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JERRY SMITH  
Administrative Patent Judge )  
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LEE E. BARRETT  
Administrative Patent Judge )  
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